



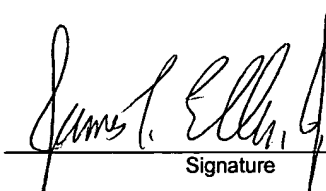
Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 4515-0103P	
		Application Number 10/700,551-Conf. #6092	Filed November 5, 2003
		First Named Inventor Sang-Ho LEE	
		Art Unit 3731	Examiner C. H. Sam
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>39,538</u></p> <p> _____ Signature James T. Eller, Jr. _____ Typed or printed name (703) 205-8000 _____ Telephone number May 17, 2006 _____ Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			



Box AF
PRE-APPEAL BRIEF REQUEST FOR REVIEW
EXPEDITED PROCEDURES EXAMINING
GROUP 3731

PATENT
4515-0103P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant:	Sang-Ho LEE	Conf. No.:	6092
Appl. No.:	10/700,551	Group:	3731
Filed:	November 5, 2003	Examiner:	C.H. Sam
For:	DISPOSABLE SURGICAL SCALPEL		

PRE-APPEAL BRIEF REQUEST FOR REVIEW REASONS

MS AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Office Action dated March 8, 2006, the following reasons in support of a Pre-Appeal Brief Request for Review are respectfully submitted in connection with the above-identified application. A Notice of Appeal is being filed on even date herewith.

REASONS

Claims 2-6 are now present in this application. Claims 2 and 4-6 are independent.

Background

On March 8, 2006, in a final Office Action, claims 2-6 were rejected under 35 USC § 103(a) as unpatentable over U.S. Patent 5,571,127 to DeCampi in view of U.S. Patent 5,344,424 to Roberts and further in view of U.S. patent 5,599,351 to Haber.

On April 4, 2006, Applicant's below-named representative asked Examiner Sam to reconsider the rejection, indicating, among other things, that most of Applicant's arguments presented in the Amendment filed on August 10, 2005 were not addressed in the March 8, 2006 Office Action, and asking the Examiner to consider those arguments. A four-line response to Applicant's arguments is found on page 3 of the March 8, 2005 Office Action. Later the same day, Examiner Sam informed Applicant's below-named representative that he had reconsidered the final rejection and decided to adhere to it.

Grounds of Rejection and Review/Rebuttal Reasons

Claims 2 and 3 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,571,127 to DeCampi in view of U.S. Patent 5,344,424 to Roberts et al. ("Roberts") and further in view of U.S. Patent 5,599,351 to Haber et al. ("Haber"). This rejection is respectfully traversed.

The final Office Action fails to make out a *prima facie* case of obviousness of the claimed invention for a number of reasons. Proper motivation to modify DeCampli, the base reference in this rejection, in view of the two secondary references is missing at least because of (1) a fundamental mis-interpretation of the meaning of the language “integrally fixed” in the clause “a blade-fixing member to which a rear end of the blade is integrally fixed,” resulting in the proposed modification of DeCampli by Roberts which will result in DeCampli not being able to use scalpel blades having standard surgical posts, as shown, for example, in Fig. 3 of DeCampli, which is a stated object of DeCampli’s invention, thereby teaching away from the proposed modification of DeCampli in view of Roberts; (2) the absence of any need in DeCampli to be modified to achieve a one-piece blade and blade-holder feature; (3) the absence of any deficiency in DeCampli that would properly motivate a skilled worker to modify DeCampli, as suggested; (4) the significant fundamental differences between the blade holder features of the applied references, including DeCampli’s single finger operated, top mounted button 27, versus Roberts’ side mounted single knob 42 that is movable between three distinct positions, as explained in the Abstract, versus Haber’s side mounted plural detents (D1, 14, 16, 26, , etc.).

The Office Action also is improper because it never provides details about how DeCampli is to be modified to result in a properly working scalpel. Instead of explaining how DeCampli, as proposed to be modified, will result in an

operative device, the Office Action merely concludes that it would be obvious to modify Haber by having a second fixing projection interlocked with the second fixing groove. However, DeCamppli has neither a second fixing projection (the first fixing projection being stated to be button 27) nor a second fixing groove (the first not being identified in the rejection), nor does DeCamppli need one to operate properly, nor does the Office Action explain why one of ordinary skill in the art would be motivated to provide a second fixing groove in an unidentified location that may or not be needed, or cause DeCamppli to continue to work properly.

Additionally, the final Office Action fails to address numerous arguments presented by Applicant on pages 9-17 of the Amendment filed on August 10, 2005, in violation of the explicit requirement to address all of applicant's arguments, set forth in MPEP §707.07(f). Instead of responding on the merits to Applicant's numerous arguments, the Office Action's Response to Applicant's Arguments provides is less than four full lines on page 3 of the final Office Action and only addresses why the secondary Roberts reference was applied, i.e., to teach a sharp blade integrally fixed to the blade fixing member, instead of addressing why Roberts was needed to modify DeCamppli, which already discloses a sharp blade 50 integrally fixed to a blade fixing member (blade carrier 40) and highlights the Examiner's apparent misunderstanding of "integral" to necessarily mean "one-piece," instead of addressing Applicants arguments regarding improper motivation and failure to provide explanatory details of what

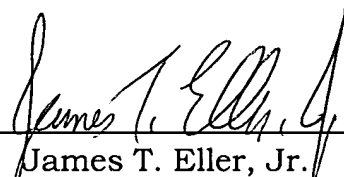
the proposed modification of DeCampi will look like and how it will operate, leaving such details to further invention.


Accordingly, Applicant respectfully requests that the final rejection of claims 2-6 under 35 USC §103(a) be reversed.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 
James T. Eller, Jr.
Reg. No.: 39,538

JTE/RJW/gf 

P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703)205-8000